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must be a reasonable expectation of success. Finally, the prior art reference must teach or suggest all the claim limitations. See MPEP 2143 (August, 2001).

I. Alper does not teach or suggest all the claim limitations

Independent claims 1 and 30 are directed to hot melt adhesive compositions that require, among other things, that the amount of substantially aliphatic high Tg tackifying resin(s) is less than the amount of the base polymer(s).

Alper teaches a hot melt adhesive composition that requires higher amount of a compatible tackifying resin than the base polymer.

The Office Action noted that Alper did not teach less amount of tackifier than base polymer. It is undisputed that Alper fails to disclose a hot melt adhesive composition that includes, among other things, less amount of substantially aliphatic high Tg tackifying resin(s) than the base polymer(s). Therefore, Alper lacks at least one required element of claims 1 and 30. Applicants submit that on this basis alone the rejection of claims 1 and 30 and all the related dependent claims under 35 U.S.C. 103 (a) over Alper is unwarranted and should be withdrawn.

Likewise, Alper teaches a hot melt adhesive composition that requires a SIS block copolymer as base polymer. Independent claims 20, 22 and 26 are directed to hot melt adhesive compositions that require, among other things, that the base polymer is chosen from copolymers and terpolymers of ethylene, amorphous polyalphaolefins, homogenous ethylene/ α -olefin interpolymers, and mixtures thereof. The Office Action also acknowledged that Alper addressed the disadvantages of using copolymer and terpolymers that incorporate olefins. It is undisputed that Alper fails to teach a hot melt

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adhesive composition that includes, among other things, a base polymer chosen from copolymers and terpolymers of ethylene, amorphous polyalphaolefins, homogenous ethylene/ α -olefin interpolymers, and mixtures thereof. Therefore, Alper lacks at least one required element of claims 20, 22 and 26. Applicants submit that on this basis alone the rejection of claims 20, 22 and 36 and all the related dependent claims under 35 U.S.C. 103 (a) over Alper is unwarranted and should be withdrawn.

II. There is no suggestion or motivation to modify Alper

Alper is further deficient for at least the following reasons.

To support an assertion of obviousness based on a single prior art reference, there must be a suggestion or motivation to modify the teachings of that reference to achieve the claimed invention. *In re Kotzab*, 217 F.3d 1365 (Fed. Cir. 2000), citing *B.F. Goodrich Co. v. Aircraft braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ 1314, 1318 (Fed. Cir. 1996).

Alper provides no such suggestion or motivation. Alper intends to achieve properties e.g., elevated temperature resistance, (col. 4, lines 65-66). In doing so, Alper uses higher amount of tackifier than base polymer and a SIS base polymer. It is undisputed that Alper teaches higher amount of tackifier than base polymer. Alper does not teach or suggest less amount of tackifier than base polymer. Moreover, there is nothing in Alper that would teach or suggest less amount of tackifier than base polymer. In other words, there is nothing in Alper that would have suggested or motivate the skilled artisan to optimize the properties e.g., elevated temperature resistance by

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manipulating the amounts of ingredients in a manner completely opposite to what Alper has taught.

Moreover, as stated in the specification, prior to Applicants' invention, skilled artisan believes it that higher level of tackifying resin than base polymer achieves high heat resistance. (specification, p. 2, para. 2).

Thus, casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art reference and the then-accepted wisdom in the field, *In re Kotzab*, 217 F.3d 1365 (Fed. Cir. 2000), citing *Dembiczak*, 175 F. 3d at 999, 50 USPQ2d at 1617, a skilled artisan without the knowledge of the claimed invention but with the then-accepted knowledge—higher level of tackifying resin than base polymer achieves high heat resistance, and guided by the only reference Alper—who teaches higher amount of tackifying resin than base polymer to achieve elevated temperature resistance, would have no reason or desirability to manipulate the amounts of ingredients in the manner opposite to what Alper has taught in order to optimize the properties e.g., elevated temperature resistance, as suggested by the Office Action.

Likewise, Alper does not teach or suggest a base polymer chose from copolymers and terpolymers of ethylenc, amorphous polyalphaolefins, homogenous ethylenc/ α -olefin interpolymers, and mixtures thereof. Alper teaches using SIS base polymer to overcome poor elevated temperature resistance associated with the use of copolymers of ethylene, c.g., ethylene vinyl acetate copolymers (EVA), and amorphous polypropylene (APP). Alper specifically addresses that these polymers lacked the desired elevated temperature resistance. (col. 1, lines 38). Clearly, Alper does not provide any suggestion or

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desirability of modifying his SIS base polymer by replacing it with the disadvantageous ethylene vinyl acetate (EVA) or amorphous polypropylene (APP) to improve properties e.g., elevated temperature resistance. Moreover, there is nothing in Alper that would teach or suggest the use of a base polymer chosen from copolymers and terpolymers of ethylene, amorphous polyalphaolefins, homogenous ethylene/ α -olefin interpolymers, and mixtures thereof to achieve his intended purpose. Instead, Alper stated, "Those skilled in the art will recognize that adhesives based upon EVA or APP cannot generally be formulated as multi-purpose adhesive composition". (col. 1, lines 53-55). Thus, a skilled artisan without the knowledge of the claimed invention but with the then-accepted knowledge--adhesives based upon EVA or APP cannot generally be formulated as multi-purpose adhesive composition, and guided by the only reference Alper--who teaches the shortcomings of using EVA or APP to achieve elevated temperature resistance, would have no reason or desirability to modify Alper in the manner clearly contrary to what he has taught.

The Office Action states that because this patent Alper acknowledges the utilization of the claimed olefins in the past, so the incorporation thereof is obvious. (Office Action, p. 3).

Applicants submit that the mere fact that ethylene vinyl acetate (EVA) or amorphous polypropylene (APP) was used in the past cannot present itself as such sufficient or relevant evidence to defeat the patentability of any inventions made thereafter e.g., Applicant's invention, simply because these inventions incorporate the already known material. Alper also acknowledged the utilization of SIS base polymer in the past (see col. 3, lines 16-32). However, the acknowledgment or the fact that SIS block

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copolymer was used prior to Alper did not render Alper's incorporation thereof obvious. Had it done so, Alper would not have obtained his patent. Identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *In re Kotzab*, 217 F.3d 1365 (Fed. Cir. 2000), citing *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). (If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue.).

Applicants submit that the reference must be reviewed without the benefit of impermissible hindsight version afforded by the claimed invention. See MPEP 2141.01 (Aug. 2001). Absent the knowledge of Applicants' own invention, there is no teaching or suggestion in Alper and/or in the then-accepted knowledge that would have motivated a skilled artisan to modify Alper in the manner claimed.

As Alper does not provide any reason to motivate the ordinary skilled in the art to modify his invention in the manner opposite to what he taught and Alper does not teach or suggest all the claimed limitations, there is no *prima facie* case of obviousness. If it is not shown that the prior art gives a reason or motivation to make the claimed composition, there is no *prima facie* case. Then the applicant is not required to make a showing of unexpected results. See *In re Grabiak*, 769 F.2d 729 (Fed. Cir. 1985). Even though it is not required, Applicants have presented the evidence of unexpected results in the Preliminary Amendment submitted to the Office on April 1, 2002, such as, very high heat resistance achieved with less amount of substantially aliphatic high Tg tackifying resin and with base polymer e.g., ethylene vinyl acetate (EVA), relative to


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Alper. Accordingly, Applicants submit that the rejection of claims 1-30 under 35 U.S.C.103 (a) over Alper is unwarranted and request that it be withdrawn.

In view of all the forgoing, Applicants submit that claims pending in the application are in condition for allowance and action in accordance therewith is respectfully requested. In the event that claims are not allowed, Applicants specifically request a personal or telephonic interview if doing so would facilitate the prosecution of the application to allowance.

Respectfully submitted,

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